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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,100	11/26/2001	Kenneth A. Hill SR.	071554.0102	2510
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FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER KOPPIKAR, VIVEK D	
			ART UNIT 3626	PAPER NUMBER
DATE MAILED: 01/20/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/996,100

Applicant(s)

HILL ET AL.

Examiner

Vivek D. Koppikar

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/26/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date all received.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Status of the Application***

1. Claims 1-26 are pending and have been examined in this application. The Information Disclosure Statement (IDS) filed on March 12, 2003; March 2, 2004 and May 5, 2004 have all been acknowledged.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2002/0032582 to Feeney in view of 2002/0032582 to Feeney in view of US Patent Number 6,549,956 to Bass.

(A) As per claims 1 and 5, Feeney a system for processing prescription requests (Feeney: Abstract), comprising:

a pharmacy prescription processing subsystem (Feeney: Sections [0177]); and

a central fill prescription processing subsystem coupled to said pharmacy prescription processing subsystem by a transmission medium, said pharmacy prescription processing subsystem operable to (Feeney: Sections [0177]):

receive a plurality of prescription requests (Feeney: Sections [0177]);

create a queue of prescription requests from said received plurality of prescription requests, each prescription request in said queue eligible to be filled by a central fill inventory

transmit said converted queue of prescription requests to said central fill prescription processing subsystem by said transmission medium, said central fill prescription processing subsystem operable to (Feeney: Sections [0177] and [0228]):

receive said converted queue of prescription requests with said transmission format (Feeney: Section [0183]);

fill a plurality of prescription requests in said queue of prescription requests from said central fill inventory (Feeney: Sections [0182]-[0184]); and

dispense a plurality of drugs from said central fill inventory, said dispensed plurality of drugs associated with said plurality of filled prescription requests (Feeney: Sections [0182]-[0185]).

Feeney does not teach the means of converting the queue of the prescription requests to a transmission format nor does Feeney teach the step of converting the queue of prescription requests from the transmission format to a processing format, however, these features are well known in the art as evidenced by Bass (Bass: Col. 7, Ln. 41-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the system of Feeney with the aforementioned feature from Bass with the motivation of providing a means of converting information into a format acceptable by a network, as recited in Bass (Bass: Col. 2, Ln. 14-17). As per claim 5, in the combined system of Feeney in view of Bass the network operates is a TCP/IP network (Bass: Col. 2, Ln. 14-17).

(B) As per claim 2, in the combined system of Feeney in view of Bass the transmission medium comprises a Unix Tunnel Daemon (Feeney: Section [0173]).

(C) As per claims 3-4, in the combined system of Feeney in view of Bass the transmission

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medium is STP Daemon and is in a packet data format (Bass: Col. 3, Ln. 36-42 and Col. 6, Ln. 6-10).

(D) As per claim 8, in the combined system of Feeney in view of Bass there is a billing subsystem coupled to the pharmacy prescription processing subsystem, the billing subsystem operable to process a claim for payment for at least one of the plurality of prescription requests (Feeney: Section [0205]).

(E) As per claim 9, Feeney pharmacy prescription processing system (Feeney: Abstract), comprising: means for entering a prescription request (Feeney: Section [0177]); and a processor coupled to said means for entering (Feeney: Section [0177]), said processor operable to: receive a plurality of prescription requests (Feeney: Section [0177]); create a queue of prescription requests from said received plurality of prescription requests, each prescription request in said queue eligible to be filled by a central fill inventory (Feeney: Section [0177] and [0228]); and transmit the queue of prescription requests to a central fill prescription processing system (Feeney: Section [0183]-[0185]). Feeney does not teach the means of converting the queue of the prescription requests to a transmission format, however, this feature is well known in the art as evidenced by Bass (Col. 7, Ln. 41-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the system of Feeney with the aforementioned feature from Bass with the motivation of providing a means of converting information into a format acceptable by a network, as recited in Bass (Bass: Col. 2, Ln. 14-17).

(F) As per claim 10, Feeney teaches a central fill prescription processing system, comprising:

a processor (Feeney: Section [0177]) ; and a central fill inventory, said processor coupled to said central fill inventory and operable to (Feeney: Section [0177]):  
a processor (Feeney: Section [0177]); and a central fill inventory, said processor coupled to said central fill inventory and operable to: receive a queue of prescription requests in a predetermined transmission format(Feeney: Section [0177]); fill a plurality of prescription requests in said queue of prescription requests from said central fill inventory (Feeney: Sections [0177] and [0228]); and dispense a plurality of drugs from said central fill inventory, said dispensed plurality of drugs associated with said plurality of filled prescription requests (Feeney: Sections [0182]-[0185]).

Feeney does not teach a means whereby a queue is converted from a predetermined format to a processing format, however, this feature is well known in the art as evidenced by Bass (Col. 7, Ln. 41-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the system of Feeney with the aforementioned feature from Bass with the motivation of providing a means of converting information into a format acceptable by a network, as recited in Bass (Bass: Col. 2, Ln. 14-17).

(G) As per claim 11, Feeney teaches a pharmacy prescription processing method (Feeney: Abstract), comprising the steps of:

receiving a plurality of prescription requests (Feeney: Section [0177]);  
creating a queue of prescription requests from the received plurality of prescription requests, each prescription request in the queue eligible to be filled by a central fill inventory (Feeney: Sections [0177] and [0228]);

transmitting the converted queue of prescription requests to a central prescription processing system (Feeney: Sections [0177] and [0228]).

Feeney does not teach the step of converting the queue of the prescription requests to a transmission format, however, this feature is well known in the art as evidenced by Bass (Col. 7, Ln. 41-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the system of Feeney with the aforementioned feature from Bass with the motivation of providing a means of converting information into a format acceptable by a network, as recited in Bass (Bass: Col. 2, Ln. 14-17).

(H) As per claim 12, Feeney teaches a central fill prescription processing method (Feeney: Abstract), comprising the steps of:

receiving a queue of prescription requests in a predetermined transmission format (Feeney: Sections [0177] and [0228]);

filling a plurality of prescription requests in said queue of prescription requests from a central fill inventory (Feeney: Sections [0177] and [0228]); and

dispensing a plurality of drugs from said central fill inventory, said dispensed plurality of drugs ass converting said queue of prescription requests from said predetermined transmission format to a processing format associated with said plurality of filled prescription requests (Feeney: Section [0177]).

Feeney does not teach the step of converting said queue of prescription requests from said predetermined transmission format to a processing format, however, this feature is well known in the art as evidenced by Bass (Col. 7, Ln. 41-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the system of Feeney with the

aforementioned feature from Bass with the motivation of providing a means of converting information into a format acceptable by a network, as recited in Bass (Bass: Col. 2, Ln. 14-17).

(I) As per claim 13, Feeney teaches a method for processing prescription requests (Feeney: Abstract), comprising the steps of:

a pharmacy prescription processing subsystem receiving a plurality of prescription requests (Feeney: Section [0177]);

creating a queue of prescription requests from said received plurality of prescription requests, each prescription request in said queue eligible to be filled by a central fill inventory (Feeney: Sections [0177] and [0228]);

transmitting said converted queue of prescription requests to a central fill prescription processing subsystem (Feeney: Sections [0177] and [0228]);

said central fill prescription processing subsystem receiving said converted queue of prescription requests (Feeney: Section [0177]);

filling a plurality of prescription requests in said queue of prescription requests from said central fill inventory (Feeney: Sections [0182]-[0185]); and

dispensing a plurality of drugs from said central fill inventory, said dispensed plurality of drugs associated with said plurality of filled prescription requests (Feeney: Sections [0182]-[0185]).

Feeney does not teach the step of converting the queue of prescription requests to a transmission format and converting said queue of prescription requests from said transmission format to a processing format, however, these features are well known in the art as evidenced by Bass (Bass: Col. 7, Ln. 41-45). At the time of the invention, it would have been obvious for one



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of ordinary skill in the art to have modified the system of Feeney with the aforementioned feature from Bass with the motivation of providing a means of converting information into a format acceptable by a network, as recited in Bass (Bass: Col. 2, Ln. 14-17).

(J) As per claim 14, in the combined method of Feeney in view of Bass the transmission medium comprises a Unix Tunnel Daemon (Feeney: Section [0173]).

(K) As per claims 15-16, in the combined method of Feeney in view of Bass the transmitting step comprises transmitting the converted queue of prescription requests with at least one STP and the transmission format comprises a packet data format (Bass: Col. 3, Ln. 36-42 and Col. 6, Ln. 6-10).

(L) As per claim 18, in the combined method of Feeney in view of Bass there is a step of processing a claim for payment for at least one of said plurality of prescription requests (Feeney: Section [0295]).

4. Claim 19-20 and 22-23 are rejected under 35 U.S.C. 103(a) under Feeney in view of US Patent Application Publication 2003/0093321 to Bodmer and US Patent Application Publication 2003/0093307 to Renz.

(A) As per claim 19, Feeney teaches a method of processing prescription requests (Feeney: Abstract), comprising the steps of:

entering at least one prescription request into a queue of prescription requests to be filled (Feeney: Section [0177]);

if said at least one prescription request can be filled by said brand name drug from said central fill inventory, assigning said brand name drug to fill said at least one prescription request (Feeney: Section [0177]);

if said at least one prescription request has been assigned for filling from said central fill inventory, sending said prescription fill queue including said at least one prescription request to a dispensing system associated with said central fill inventory for filling (Feeney: Section [0177]).

Feeney does not teach the steps of determining if said at least one prescription request is eligible to be filled from a central fill inventory; if said at least one prescription request is eligible to be filled from said central fill inventory, determining if said at least one prescription request can be filled by a brand name drug from said central fill inventory; and if said at least one prescription request is not eligible to be filled from said central fill inventory, assigning said at least one prescription request to be filled from a local inventory, however these features are taught in Bodmer (Section [0039]). At the time of the invention, it would have been obvious to one of ordinary skill in the art to have modified the method of Feeney with the aforementioned features from Bodmer with the motivation of developing an improved electronic prescription system to seamlessly incorporate products and services from third parties (various sources) into on e-commerce site, as recited in Bodmer (Section [0033]).

The combined system of Feeney in view of Bodmer does not teach the steps of if said at least one prescription request cannot be filled by a brand name drug from said central fill inventory, determining if a second drug from said central fill inventory can be substituted for said brand name drug; and if said at least one prescription request can be filled by a second drug from said central fill inventory, assigning said second drug to fill said at least one prescription request; if said at least one prescription request cannot be filled by a second drug from said central fill inventory, assigning said at least one prescription request to be filled from said local inventory; however, these features are well known in the art as evidenced by Renz (Section

[0017]). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined method of Feeney in view of Bodmer with the aforementioned features from Renz with the motivation of providing a means of adapting a supply chain network to environmental changes without compromising on operation and financial efficiencies (ensuring that a customer's order is satisfied efficiently), as recited in Renz (Section [0009]).

(B) As per claim 20, the combined system of Feeney in view of Bodmer and Renz teaches the following step: if at least one prescription request has been assigned for filling from the central fill inventory, sending billing information associated with at least one prescription to a payment system (Feeney: Section [0205]).

(C) As per claim 22, the combined system of Feeney in view of Bodmer and Renz teaches wherein the step of sending the prescription fill queue including at least one prescription request to a dispensing system associated with the central fill inventory for filling comprises conveying at least one data packet including at least one prescription request using at least on Unix or one STP Daemon (Feeney: Section [0173]).

(D) As per claim 23, the combined system of Feeney in view of Bodmer and Renz teaches that the prescription fill queue comprises a plurality of prescription requests (Feeney: Section [0228]).

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feeney in view of Bass and in further view of US Patent Application Publication 2002/005260 to Munoz.

(A) As per claim 6, Feeney in view of Bass does not teach or suggest an IVR (interactive voice response) system for entering at least one of a plurality of prescription requests to the

pharmacy processing subsystem, however, this feature is well known in the art as evidenced by Munoz (Section [0058]). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined system of Feeney in view of Bass with the aforementioned teachings from Munoz with the motivation of providing a more convenient means of allowing a hosting physician to process and create new prescriptions (Munoz: Section [0058]).

(B) As per claim 17, Feeney in view of Bass does not teach or suggest an IVR (interactive voice response) system for entering at least one of a plurality of prescription requests to the pharmacy processing subsystem, however, this feature is well known in the art as evidenced by Munoz (Section [0058]). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined method of Feeney in view of Bass with the aforementioned teachings from Munoz with the motivation of providing a more convenient means of allowing a hosting physician to process and create new prescriptions (Munoz: Section [0058]).

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feeney in view of Bass and in further view of PDXinc.com (published on August 3, 2001).

(A) As per claim 7, Feeney in view of Bass does not teach or suggest a PDX Host system coupled to said pharmacy prescription processing subsystem; and

an NHIN system coupled to said PDX Host system and said central fill prescription processing subsystem, however these features are taught in PDXinc.com. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the

system of Feeney in view of Bass with the aforementioned teaching from PDXinc.com with the motivation of providing an improved electronic prescription system, as is taught in PDXinc.com.

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feeney in view of Bodmer and Renz and in further view of Takahashi.

(A) As per claim 21, the combined method of Feeney in view of Bodmer and Renz does not teach or suggest a step wherein if a claim for payment associated with said at least one prescription request is not paid by said payment system within a predetermined amount of time, generating an error message to report that said claim has not been paid, however, this feature is well known in the art as evidenced by Takahashi (Col. 8, Ln. 61-65). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined method of Feeney in view of Bodmer and Renz with the aforementioned teaching from Takahashi with the motivation of providing a warning message to the user when a payment is overdue, as recited in Takahashi (Takahashi, Col. 8, Ln. 61-65).

8. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feeney in view of US Patent Application Publication to 2002/0038259 to Bergman.

(A) As per claim 24, Feeney teaches a method of processing prescription request (Feeney: Abstract), comprising the steps of:

receiving a plurality of prescription requests to be filled (Feeney: Section [0177]);  
selecting at least one prescription request from said plurality of prescription requests (Feeney: Section [0228]);

if said central fill inventory has adequate inventory to fill said at least one prescription request, allocating a dispense quantity for said at least one prescription request (Feeney: Section [0177] and [0228]);

if a dispense quantity has been allocated for said at least one prescription request, dispensing said dispense quantity from said central fill inventory (Feeney: Sections [0182]-[0184]).

Feeney does not teach the steps of determining if a central fill inventory has adequate inventory to fill said at least one prescription request; if said central fill inventory has inadequate inventory to fill said at least one prescription request, generating an error message to report that said central fill inventory has inadequate inventory to fill said prescription request; however, these feature are well known in the art as evidenced by Bergman (Section [0038]). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the method of Feeney with the aforementioned steps from Bergman with the motivation of providing a user with a means of notification if an order cannot be fulfilled.

(B) As per claim 25, in the combined method of Feeney in view of Bergman, the method comprises the steps of initiating an order pull for said plurality of prescription requests (Feeney: Section [0177]), said plurality including said at least one prescription request having an allocated dispense quantity (Feeney: Sections [0182]-[0184]); generating at least one packing slip associated with said order pull (Feeney: Section [0234]); and

substantially affixing said at least one packing slip to a tote, said tote including said dispensed

quantity from said central fill inventory, and said tote destined for a predetermined store (Feeney: Section [0234]).

(C) As per claim 26, in the combined system of Feeney in view of Bergman initiating an order pull for said plurality of prescription requests, said plurality including said at least one prescription request having an allocated dispense quantity (Feeney: Section [0177]); and

generating a summary manifest report including a plurality of orders associated with said order pull (Feeney: Section [0042]).

### *Conclusion*

9. Any inquire concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

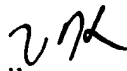
If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Sincerely,

  
Vivek Koppikar

1/9/2006

  
C. LUKE GILLIGAN  
PATENT EXAMINER